REMARKS

Status of the Claims

- Claims 106-115, 117-119, 122-138, 140-142, 145-158, 162 and 163 are pending in the Application.

- Claims 106-115, 117-119, 122-138, 140-142, 145-158, 162 and 163 are rejected by Examiner.

Claim Rejections Pursuant to 35 U.S.C. §103 (a)

Claims 106-115, 117-119, 122-138, 140-142, 145-158, 162 and 163 stand rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,226,618 to Downs et al. or U.S. Pat No. 6,343,280 to Clark in view of U.S. Pat No. 6,574,612 to Baratti et al. The Applicants respectfully traverse the rejection.

Downs et al. disclose a method and apparatus of securely providing data to a user's system. The data is encrypted so as to only be decryptable by a data decrypting key, the data decrypting key being encrypted using a first public key, and the encrypted data being accessible to the user's system, the method comprising the steps of: transferring the encrypted data decrypting key to a clearing house that possesses a first private key, which corresponds to the first public key; decrypting the data decrypting key using the first private key; re-encrypting the data decrypting key using ia second public key; transferring the re-encrypted data decrypting key to the user's system, the user's system possessing a second private key, which corresponds to the second public key; and decrypting the re-encrypted data decrypting key using the second private key. (Col. 3, lines 41-55)

Clark discloses a method of protecting an "executable image" of original software from unlicensed use. A method includes selecting sequences of instructions and replaced with instructions that interrupt the normal flow of execution and transfer control to a license server. The result is that a client computer executes a modified executable until the replaced sequences interrupt the normal flow of execution and transfer control to the license server. The license server executes the instructions which were replaced in the modified executable upon proper authorization by emulating the client microprocessor. (See Abstract).

Clark teaches:

The method *requires* modification of the executable code of the software to be protected such that certain portions of the executable code operate on a License Server while the software to be protected operates on the authorized user's computer. (col. 4 line 67 – col. 5, line 4).

From FIG. 1, the method of the instant invention can be seen. The method begins with a Software Vendor 3 who is in possession of Original Software 9 that the Software Vendor 3 wishes to sell to a Software User 2. The Original Software 9 is in fully compiled, executable form. The Software Vendor 3 causes the Software Profiler 10 to operate on the Original Software 9. *The Software Profiler 10 acts to remove certain selected executable instructions from the Original Software 9*, creating the Software Vendor's 3 copy of the Modified Software 7. (col. 14 lines 31-40).

The Software Vendor 3 then sells and communicates 15 (by any transfer means, including without limitation on disk, by internet download, on CD-ROM, or otherwise) *the Modified Software* 7 to the Software User 2. (col. 14 lines 45-48).

All three objects, the Modified Software 7, the User Key 5 and the Trap Software 6 *must be installed* on the Software User's 2 computer for the method of the instant invention to work. (co. 14, lines 51-54).

Thus, Clark teaches that the Original Software, is "required" to be modified such that only a portion of the original software, called modified software, is actually sold to the user. The modified software cannot fully be fully executed by the user without the three mandatory components of modified software, user key, and trap software loaded on a users computer. The modified software cannot fully execute on the users computer because the modified software lacks a full set of executable program instructions. The remaining set of executable program instructions are given to a license server for remote execution. Thus Clark teaches that the user never acquires a full copy of the executable software that is purchased to run on the user computer.

Baratti discloses a method and system for providing flexibility to a license management system. A license management system permits the concurrent use of n copies of a software program over a network comprising a plurality of client workstations, each client workstation having a copy of the software program installed thereon requiring an authorization from one of a plurality of S license servers each time the software program is used. (Abstract)

Claim 106 recites:

A digital rights management (DRM) system operating on a computing device when a user requests that a protected piece of digital content be rendered by the computer device in a particular manner, the system comprising:

a rendering application by which the requested digital content is rendered;

a license store for storing one or more digital licenses on the computing device, the license store providing access to the one or more digital licenses separately from the requested digital content;

a license evaluator for determining whether any licenses stored in the license store correspond to the requested digital content, for determining whether any such corresponding licenses are valid, for reviewing license rules in each such valid license, and for determining based on such reviewed license rules whether such license enables the requesting user to render the requested digital content in the manner sought;

a state store for maintaining state information corresponding to each license in the license store, the state information being created and updated by the license evaluator as necessary; and

a black box for performing encryption and decryption functions as part of the evaluation of any license,

wherein the license evaluator selects an enabling, valid license and works with the black box to obtain a decryption key (KD) from the selected license, and wherein the black box employs such decryption key (KD) to decrypt the protected digital content, and

wherein the black box decrypts the protected digital content when the license evaluator determines that a license in fact enables the requesting user to render the requested digital content in the manner sought.

First, considering the combination of Downs et al. and Baratti et al., Applicants submit that Downs et al., as discussed by an Examiner in an Office Action dated 6/14/2000 fails to disclose a state store for maintaining state information corresponding to each license in the license store, the state information being created and updated by the license evaluator as necessary. Applicants agree with the Examiner on this point. This deficiency is not cured by Baratti et al. which fails to teach a state store of any kind. Applicants submit that neither Downs et al. or Baratti et al. considered separately or combined, teach or suggest a state store for maintaining state information corresponding to each license in the license store, the state information being created and updated by the license evaluator as recited in Claim 106. Since

the combination of Downs et al. and Baratti et al. fail to teach or suggest all elements of Claim 106, they cannot render obvious Claim 106 under 35 USC §103(a).

Second, considering the combination of Clark and Baratti et al., Applicants submit that Crown fails to disclose a state store for maintaining state information corresponding to each license in the license store, the state information being created and updated by the license evaluator as necessary as recited in Claim 106. Specifically, Applicants find that a CPU state as discussed by Clark consists of the instruction pointer and CPU registers. (col. 27, lines 3-4). However, Clark fails to disclose a state store for maintaining state information corresponding to each license in the license store, the state information being created and updated by the license evaluator as necessary as recited in Claim 106. Moreover, as discussed above, Clark discloses selling modified executable software to a user instead of fully functional original software. The original software of Clark is required to be changed into modified software that is only a portion of the original software and that cannot fully be executed by the user without mandatory trap software and a user key installed on the users computer. Applicants submit that Clark teaches that the user never acquires a full copy of the executable software that is purchased.

Claim 106 recites no such limitations as are mandated by Clark. Claim 106 does not require that the digital content be modified. Claim 106 does not require that the user obtain only a portion of the digital content. Claim 106 does not require that a license server become involved in the execution of the digital content. Claim 106 does not require that trap software be installed on the users computer to aid in the execution of the digital content. Applicants submit that the mechanism of Clark is substantially different form that recited in Claim 106 because Clark mandates substantial limitations not present in Claim 106.

The addition of Barati et al. to Clark does not cure the deficiency to disclose a state store for maintaining state information corresponding to each license in the license store, the state information being created and updated by the license evaluator as necessary as recited in Claim 106. In addition, the mandatory modification of software in Clark is incompatible with the teachings of Baratti et al. which suggests that each client on a network has a full copy of the executable software. This suggestion is derived from the fact that Baratti et al. does not mention a mandatory modification of software on the client computers such that a client only have a portion of the executable software.

Applicants submit that neither Clark nor Baratti et al. considered separately or combined, teach or suggest a state store for maintaining state information corresponding to each license in the license store, the state information being created and updated by the license evaluator as necessary as recite in Claim 106. Since the combination of Clark and Baratti et al. fail to teach or suggest all elements of Claim 106, they cannot render obvious Claim 106 under 35 USC §103(a).

Since, independent Claims 129 and 152 also include the element of a state store having information corresponding to each license in the license store, where the state store is created and updated as necessary, then Claims 129 and 152 also patentably define over the cited art.

Similarly, dependent Claims 107-115, 117-119, 122-128 which rely on independent Claim 106, dependent Claims 130-138, 140-142, 145-151 which rely on independent Claim 129 and dependent Claims 152-158, 162 and 163 which rely on independent Claim 152 are also rendered non-obvious and patentably define over the cited art.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection and reconsideration of all pending claims as they patentably define over the cited art.
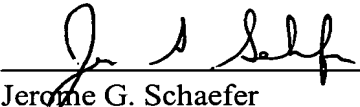
Conclusion

Applicants respectfully request reconsideration of all pending claims in light of the discussion above. Applicants respectfully request a Notice of Allowance for all pending claims as they patentably define over the cited art.

Respectfully Submitted,

Date: August 29, 2005

Jerome G. Schaefer
Registration No. 50,800

Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439